

REMARKS

It is respectfully requested that this application be reconsidered in view of the above amendments and the following remarks and that all of the claims remaining be allowed.

Claims Amendments:

Claims 1-6 and 8-23 have been canceled without prejudice or disclaimer. Applicants specifically reserve the right to file at least one continuing application to prosecute the canceled subject matter.

Claim 26 has been amended to recite that the virus is selected from the group consisting of reoviruses, vaccinia viruses having a mutation in the K3L or E3L genes, herpes simplex viruses having a mutation in the γ_1 34.5 gene, parapoxviruses having a mutation in the OV20.0L gene, and adenoviruses having a mutation in the E1A or E1B gene. Support for this recitation can be found, for example, at page 6, lines 13-14; page 16, lines 4-9 and 19-24; page 15, lines 18-23; page 25, lines 17-18; and page 26, lines 1-2.

Claim 26 has been also amended to recite a step (c) of collecting the resulting composition. Support for this recitation can be found, for example, in the original claim 1.

Claims 28 and 29 have been amended to depend from claim 27 instead of claim 26 to correct a typographical error.

Claims 30, 32 and 33 have been amended to recite "mixed cellular composition" or "cellular composition with a reduced amount of neoplastic cells" for clarity.

No new matter has been added by these amendments. The Examiner is hereby requested to enter these amendments.

Applicants submit that all claim amendments presented herein or previously are made solely in the interest of expediting allowance of the claims and should not be interpreted as acquiescence to any rejections or ground of unpatentability. Applicants reserve the right to file at least one continuing application to pursue any subject matter that is canceled or removed from prosecution due to the amendments.

Election/Restrictions:

The Office Action states that claims 1-6 and 8-23 are directed to an invention that is independent or distinct from the invention previously elected in response to the restriction requirement. Claims 1-6 and 8-23 have thus been withdrawn from consideration.

Although Applicants believe that examination of claims 1-6 and 8-23 does not impose an unreasonable burden on the Examiner, these claims have been canceled to expedite allowance of the remaining claims.

Rejections Under 35 U.S.C. §112, First Paragraph:

A. The rejection of claims 26-33 under 35 U.S.C. §112, first paragraph, as allegedly unenabled, has been obviated as set forth below.

The Office Action indicates that the specification is enabling for the use of a reovirus, a vaccinia virus having mutations in the K3L or E3L genes, a herpes simplex virus having a mutation in the ICP34.5 gene, a parapoxvirus having a mutation in the OV20.0L gene, or an adenoviruses having a mutation in the E1A or E1B gene in the claimed method (page 3, last 5 lines of the Office Action). Claims 26-33 have been amended to recite that the virus is selected

from the group consisting these viruses¹. Therefore, withdrawal of this rejection is respectfully requested.

B. The rejection of claims 26-33 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such as way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention, is now moot for the reasons set forth below.

The Office Action takes the position that the claims read on a broad genus of viruses but indicates that the specification provides teaching regarding a reovirus, a vaccinia virus having mutations in the K3L or E3L genes, a herpes simplex virus having a mutation in the ICP34.5 gene, a parapoxvirus having a mutation in the OV20.0L gene, or an adenoviruses having a mutation in the E1A or E1B gene (page 8, lines 8-12 of the Office Action). Since claims 26-33 have been amended to recite that the virus is selected from the group consisting these viruses, the rejection is now moot.

Accordingly, withdrawal of this rejection is respectfully requested.

Rejections Under 35 U.S.C. §112, Second Paragraph:

A. Claims 26-33 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for not reciting a method step of collection or isolation. Claims 26-33 have been amended to recite a step of "collecting the resulting composition". Therefore, this rejection is now moot.

B. Claims 30, 32 and 33 stand rejected for lacking antecedent basis by reciting "cellular composition". These claims have been amended to recite "mixed cellular composition" or

¹ With respect to the herpes virus, the claims recite a mutation in the γ 134.5 gene, which codes for ICP34.5.

“cellular composition with a reduced amount of neoplastic cells” . Therefore, this rejection is now moot.

Accordingly, withdrawal of these rejections is respectfully requested.

Double Patenting:

Claims 26-33 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-5, 7, 8, 15, 16 and 21 of copending Application No. 09/847,356 (US 2002/0006398).

As suggested in the Office Action, Applicants hereby acknowledge that the terminal disclaimer filed on May 16, 2003 in the present application is enforceable with respect to claims 26-33. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusions:

For the reasons set forth above, Applicants submit that the claims of this application are patentable. Reconsideration and withdrawal of the Examiner's rejections are hereby requested. Allowance of the claims remaining in this application is earnestly solicited.

Applicant : Donald Morris et al.
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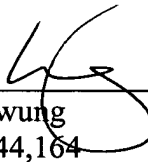
Attorney's Docket No.: 16596-011001

In the event that a telephone conversation could expedite the prosecution of this application, the Examiner is requested to call the undersigned at (650) 839-5044.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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